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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,796	12/14/2001	Erhard Mueller	24857	1639

7590 10/07/2004

NATH & ASSOCIATES PLLC  
1030 15TH Street NW - 6th Floor  
Washington, DC 20005

EXAMINER

GRAY, JILL M

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/014,796	Applicant(s) MUELLER ET AL.	
	Examiner Jill M. Gray	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 4-11 and 26-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-11, 26-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/25/04</u>   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

The cancellation of claims 2-3 and 12-25 is noted. Also, the submission of new claims 26-55 is noted. Currently, claims 1, 4-11, and 26-55 are under prosecution.

The objection of claims 7, 9 and 22 is withdrawn in view of applicants' amendment.

The rejection of claims 1, 6, 8, 10, 12-21 and 24-25 under 35 U.S.C 112, second paragraph is moot in view of applicants' amendments.

The rejection of claims 12, 14, and 17 under 35 U.S.C. 102(b) as being anticipated by Wang et al, 4,705,820 is moot in view of applicants' amendment.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 28, 38, and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More specifically, each of these claims set forth that the terpolymer contains trimethylene carbonate and e-caprolactone in a weight ratio between 95:5 to 5:95. It is unclear as to whether this ratio refers to the ratio of these components to the terpolymer per se, or if this is a ratio between the trimethylene carbonate and e-caprolactone.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-11, and 26-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al, 4,708,820 (Wang) in view of Bezwada et al, 5,371,176 and 4,994,074 (Bezwada), for reasons of record.

### ***Response to Arguments***

Applicant's arguments filed July 19, 2004 have been fully considered but they are not persuasive.

Applicants argue that one of ordinary skill in the art would not arrive at the present suture material from the cited references. Specifically, the disclosure of '820 refers to copolymers (all polymers presented in the examples are composed of only two monomers) and does not exhibit defined terpolymer compositions. The polymer of '820 is not indicated to be waxy. Instead, it has good tensile strength, which is not a relevant feature of the present waxy terpolymers.

In this regard, Wang teaches that his polymer is amorphous with a low glass temperature. This teaching would lead one of ordinary skill in the art to reasonably believe that the polymer has some degree of amorphous properties that tend towards what can be construed as "waxy". In addition, Wang specifically teaches that his polymer can contain other monomers such as caprolactones, and disclosed examples and preferred embodiments do not constitute a teaching away from a broader

Art Unit: 1774

disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Accordingly, the fact that Wang only discloses copolymers in his examples is of no moment. Note also, the claims are not all limited to any particular glass temperature or molecular mass or any other property that clearly defines what constitutes "waxy".

Applicants argue that the polymer of '074 discloses partially crystalline low molecular weight copolymers based on caprolactone and glycolide and glycolic acid is added to control molar mass and viscosity. Further arguing that such a polymer differs from the inventive terpolymer in composition, structure and characteristics.

In this regard, Bezwada, '074 is relied upon for all that he would have reasonably imparted to one of ordinary skill in the art at the time the invention was made.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants argue that with regards to the viscosity data, such data from the references cannot be readily compared to that contemplated by the present invention without recalculating and fitting to adequate conditions, because viscosity data are significantly affected by the analytical conditions employed, namely concentration.

In this concern, claims 1, 4-7, 9-11, 27-31, 34-41, and 44-46 are not limited to any particular viscosity. Moreover, the composition of Wang teaches a viscosity within

Art Unit: 1774

the range contemplated by applicants. See column 4, lines 36-40. This teaching in combination with his teachings that other monomers can be added would have reasonably suggested to the skilled artisan that even with the addition of other monomers, the desired viscosity would be within the disclosed range.

Accordingly, it is the examiner's position that the combined teachings of Wang and Bezwada would have rendered obvious the invention as claimed in the present claims.

No claims are allowed.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1774


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

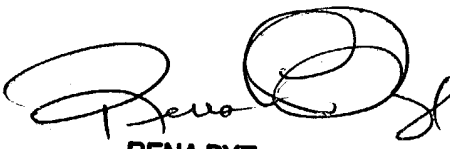
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-F 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jmg

  
Jill M. Gray  
Examiner  
Art Unit 1774

  
RENA DYE  
SUPERVISORY PATENT EXAMINER  
A.U. 1774